

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on February 25, 2008 was filed before the mailing date of the first action on the merits. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claims 1- 36 are in the case.

### ***Claim Objections***

**Claim 3** is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 3 merely recites the first clause of the "first computer system" portion of claim 1.

**Claims 1, 5, 15, 17 and 24** are objected to because of the following informalities: The claims recite that elements are "couplable" to a data network, however couplable is not a recognized word. Further, the claims subsequently transmit data over a connection between the elements and the data network, so that the coupling between elements is completed and not merely possible. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 16** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 16 provides for the use of the system of claim 1 but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 16** is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims **1-2, 4-12, 14-15, 17, 19, 20-31, and 33-36** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,989,770 to Painter (Painter) in view of U.S. Patent Pub. No.2004/0068364 to Zhao et al. (Zhao). Painter is concerned

with a navigation system including a navigation-related server and one or more customer-interface servers. Zhao is concerned with a traffic notification system that includes location determination.

Regarding independent **claim 1**, "A mobile navigation system comprising:

a first computer system couplable to a data network and comprising:" – Fig. 1 of

Painter shows a user device 130 as a personal computer (col. 3 lines 24-34)

"a prompter operable to prompt for a user mobile telephone number;

a first receiver operable to receive data identifying the mobile telephone number for the user entered in response to said prompt;

a second receiver operable to receive data identifying a desired destination; and"

– In Painter, col. 3, lines 24-27, the end user devices are used for requesting navigation related services. It is well known in the computer arts to set up a dialog to receive data from a user, with the dialog personalized for the application.

"a first transmitter operable to transmit the received telephone number data and the destination data to the data network;

a second computer system couplable to the data network and a telephone network and comprising:

a third receiver operable to receive said telephone number data and said destination data from the data network;" - In Painter Fig. 1, user device 130 transmits across the data network 140 to a customer interface server 202 to send the request to the navigation system, col. 4 lines 6-11.

"a message data generator operable to generate message data prompting the user to telephone a predetermined telephone number to receive navigation guidance information relating to said destination; and" - Painter does not mention providing a call-in telephone number for receipt of guidance information. However, Zhao is concerned with providing updates to the user and provides an administrative phone number for the requester to use to obtain such updates. (Zhao Page 7, paragraph 73 and Figure 11.) It would have been obvious to one of ordinary skill in the art at the time of the invention to improve the customer interface server of the Painter system by incorporating the known Zhao technique to provide updates guidance.

"a second transmitter operable to transmit said message data over said telephone network to the mobile telephone corresponding to the received telephone number data." - The customer interface of Painter is operable to deliver messages such as the telephone number to the user device.

Regarding **claim 2**, which is dependent on claim 1, "wherein said message data generator is operable to generate message data comprising a text message for display on a display of the mobile telephone of said user." – Painter col. 4 lines 6-8, the communications interface formats messages for the receiver device.

Regarding **claim 4**, which is dependent on claim 1, "wherein said prompter is operable to prompt the user for said destination and wherein said second receiver is operable to receive data identifying said destination from said user." - It is well known in

the computer arts to set up a dialog to receive data from a user, with the dialog personalized for the application. In Painter col. 4, lines 30-37, the customer interface is identified as receiving customer navigation requests.

Regarding **claim 5**, which is dependent on claim 1, "further comprising a user terminal couplable to a data network and comprising:

A connector operable to connect the user terminal to said first computer system and operable to receive said prompt from said prompter;

a second prompter operable to prompt the user for their mobile telephone number; and

a third transmitter operable to transmit data identifying the input mobile telephone number to said first computer system." – Painter Fig. 1 shows various user terminals including 130 connected to the data network 140 that connects them to the servers 200 and 202. Many of these are programmable to accomplish the well known tasks listed.

Regarding **claim 6**, which is dependent on claim 1, "wherein said second computer system comprises a fourth receiver operable to receive a telephone call from said user over said telephone network and a provider operable to provide navigation guidance information relating to the destination to the user." – The Painter/Zhao customer interface has an administrative phone interface to receive a telephone call and provide navigation guidance information to the user. (Zhao – Paragraph 73)

Regarding **claim 7**, which is dependent on claim 6, "wherein said second computer system comprises a determiner operable to determine the current location of the user and" – Applicant's acknowledged prior art in paragraph 2, has a computer system that interrogates the users mobile phone to determine the user's location. "a processor operable to process the current location and the desired destination with reference to predetermined road network data to determine route guidance instructions for guiding the user from the determined current location to said destination." – In Zhao Fig. 6, after receiving the call from the user, determining the current location and the destination, the system calculates the most efficient route and transmits it. This is described in paragraphs 61-63. It would have been obvious to one of ordinary skill in the art at the time of the invention to use this known procedure in a known device ready for improvement to yield predictable results of updated instructions.

Regarding **claim 8**, which is dependent on claim 6, "wherein said provider is operable to provide said route guidance instructions to said user as voice or text instructions." – Painter Fig. 1 shows receipt by devices that use both text or voice.

Regarding **claim 9**, which is dependent on claim 1, "wherein said first computer system comprises a determiner operable to determine initial route guidance information relating to said destination and a third transmitter operable to transmit said initial route guidance information to said user." – In Painter Fig. 1, the Navigation-related Information Server 200 determines an initial route and formats that route in "standard

format". The customer interface server 202 formats the standard format data into the users desired format and sends it to the user. See Summary of operation col. 2 lines 17-43.

Regarding **claim 10**, which is dependent on claim 9, "wherein said determiner is operable to determine initial route guidance information comprising text instructions or a graphical representation of one or more routes around the desired destination." - In Painter, the navigation -related server 200 and customer interface server 202 are together a remote server that determine the route and compose it into instructions for the user. Alternately, as shown block diagram in Zhao Fig. 6, a processor determines the route 68 and displays that route 69.

Regarding **claim 11**, which is dependent on claim 9, "wherein said first computer system further comprises a fourth receiver operable to receive data identifying an initial location of said user and wherein said determiner is operable to determine said initial route guidance information using said initial location and said desired destination to calculate a route from said initial location to said desired destination." - In Zhao Fig. 6, step 64, the system receives the current location and proceeds to determine the route using that data.

Regarding **claim 12**, which is dependent on claim 9, "wherein said third transmitter is operable to transmit data relating to the initial route guidance information

to said data network and wherein said third receiver is operable to receive said data relating to said initial route guidance information from said data network.” In the Painter/Zhao combination, Zhao’s functionality is incorporated in the customer interface server, which communicates through the data network 140 to the various users’ devices.

Regarding **claim 14**, which is a computer system for use in the system of claim 1, comprising:

“a receiver operable to receive telephone number data and destination data from a data network;

a message data generator operable to generate message data prompting a user of the mobile telephone corresponding to said telephone number data to telephone a predetermined telephone number to receive navigation guidance information relating to the destination corresponding to said received destination data; and

a transmitter operable to transmit said message data over the telephone network to the mobile telephone corresponding to the received telephone number data.” – In Zhao, there are two parts to the guidance process, subscribing and guiding. During the subscribing portion, as described in Zhao paragraph 52, the telephone number is received and the user is enrolled. Since in later transactions, the subscriber calls an administrative telephone number, it would have been obvious to one of ordinary skill in the art at the time of the invention that Zhao generates a message informing the

subscriber of the administrative telephone number and transmits it to the user during the subscribing process.

Regarding independent **claim 15**, "A mobile navigation system comprising:  
a first computer system couplable to a data network and comprising:  
a prompter operable to prompt for a user mobile telephone number;  
a first receiver operable to receive data identifying the mobile telephone number for the user, entered in response to said prompt;  
a second receiver operable to receive data identifying a desired destination; and  
a first transmitter operable to transmit the received telephone number data and the destination data to the data network; and  
a second computer system couplable to the data network and a telephone network and comprising:  
a third receiver operable to receive said telephone number data and said destination data from the data network;" - The elements to this point are identical to those recited in the first part of claim 1 and are rejected for the same reasons as detailed above.

"a memory operable to store said received telephone number data and said received destination data;" – Zhao shows a subscribed database 15 as part of its system shown in Fig. 1. Such a database is a memory. In Fig 8, Zhao shows storing routes (including starting location and destination) and names for routes associated with

the telephone number. If only one route were associated with a number as detailed by the applicant. The association would still provide the stored memory recited.

“a third receiver operable to receive a telephone call from said user;

a first determiner operable to determine the telephone number of the telephone being used by the user;

a retriever operable to retrieve destination data corresponding to the determined telephone number from said storing means memory;

a second determiner operable to determine route guidance information relating to said retrieved destination data; and

a second transmitter operable to transmit said route guidance information to said user via said mobile telephone.” – Zhao Fig. 11 shows these steps of receiving the call 110, identifying the phone number 111, if only one route were stored, the prompts for routes would not be used, the retrieving the route 116, and determine guidance information (traffic on route) related to the route. This operation is detailed in Zhao Paragraphs 77-79.

Regarding independent **claim 17**, - This claim is for the system of claim 1 rewritten in means for language. It is rejected under 35 USC 103(a) based on Painter/Zhao using the same rationale as above.

Regarding **claim 19**, which is a computer system for use in the system of claim 17, - this claim recites the limitations of claim 14 in “means for “ language and is

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rejected under 35 USC 103(a) as unpatentable over Painter/Zhao for the reasons detailed above.

Regarding **claims 20 – 31**, which are the method claims that correspond to system claims 1-12. These claims are rejected under 35 USC 103(a) as unpatentable over Painter/Zhao as detailed with regard to claims 1-12. While the structures detailed in claims 1-12 are not embodied in these claims, they perform the function detailed in the referenced system claims.

Regarding **claim 33**, which is a computer implemented method dependent on the system of claim 1, - This claim is the method form of claim 14 and is rejected under 35 USC 103(a) as unpatentable over Painter/Zhao for the reasons detailed above.

Regarding independent **claim 34**, which is a mobile navigation method that is the method claim that corresponds to system claim 15. This claim is rejected under 35 USC 103(a) as unpatentable over Painter/Zhao as detailed with regard to claims 15. While the structures detailed in claim 15 are not embodied in this claim, it performs the function detailed in the referenced system claim.

Regarding independent **claims 35 and 36**, these claims recite computer readable media storing computer implementable process steps to configure a programmable computer device to carry out the methods of the first and second parts of

claim 1. They are rejected under 35 USC 103(a) as unpatentable over Painter/Zhao as detailed in association with claim 1.

Claims **13, 18 and 32** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,559,707 to DeLorme et al. (DeLorme). DeLorme is concerned with a computer aided routing system for determining travel routes between user selected points.

Regarding independent **claim 13**, "A computer system for use in a mobile navigation system comprising:

- a prompter operable to prompt for a mobile telephone number of a user;
- a first receiver operable to receive data identifying the mobile telephone number of the user entered in response to said prompt;
- a second receiver operable to receive data identifying a desired destination; and
- a transmitter operable to transmit the received telephone number data and the destination data to a mobile navigation system over the internet." – The purpose of the DeLorme system is to use a computer to plan travel routes. In Figs. 1D-1F dialog boxes with the user are shown including ones to receive a telephone number (1F) and addresses (1D). The operation of these boxes is described in col.13, lines 1-10. While prompter, receiver and transmitter are not explicitly called out in this description it would have been obvious to one of ordinary skill in the art at the time of the invention to underlay these figures with software modules that prompt, receive and transmit the data.

Regarding independent **claim 18** – This claim recites the elements of claim 13 in means for language and is rejected under 35 USC 103(a) over DeLorme as detailed above.

Regarding independent **claim 32**, which is a computer implemented method form of claim 13 and is rejected under 35 USC 103(a) as unpatentable over DeLorme for the reasons detailed above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,111,539 to Mannings et al. for speech synthesis used in providing directions from a central database, U.S. Patent Pub. No. 2002/0169549 to Kaplan for providing backup driving instructions from a navigation system, and U.S. Patent Pub. No. 2004/0044470 to Matsuoka et al for route guidance from a central apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LIN B. OLSEN whose telephone number is (571)272-9754. The examiner can normally be reached on Mon - Fri, 8:30 -5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G. Black can be reached on 571-272-6956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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